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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,667	01/24/2001	Takeo Hoda	05058/02806	4380

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 04/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/768,667

Applicant(s)

HODA ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 42-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Tojo et al (5,737,014).

Regarding claims Tojo discloses a camera having a recording/reproducing apparatus (Figs. 1,3) reproducing the images signal . The apparatus comprises:

a first storing means (20) for storing a plurality of images column 2, lines 61-65);

a second memory (7) for storing a plurality of images;

a reproducing means for reproducing the image signals from the first memory and the image signal from the second memory ; and

a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 18, lines 17-26, column 7, lines 14-20).

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Tojo further reaches that the first memory is detachable and second memory is fixed since the second memory is inserted into the connection fixed in the camera (Fig. 3).

Tojo further teaches that the image pickup apparatus having body and the recorder 2 can be attached and combined with the image pickup apparatus to form a camera having a body and the first memory and second memory are installed inside the body (column 9, lines 21-45)

3. Claims 42 and 44-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Toka et al (5,162,833).

Regarding claims 42- and 44-49, Taka discloses a camera having a body recording/reproducing apparatus (Fig. 1, column ) for recording and reproducing the image signal . The apparatus comprises:

a first storing means (10) installed inside the camera body for storing a plurality of images (column 3, lines 53-65)column 2, lines 61-65) ;

a second memory (12) installed inside the camera body for storing a plurality of images;

a reproducing means (14,16) for reproducing the image signals from the first memory and the image signal from the second memory ; and

a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 8, lines 38-42, column 12, lines 55-60).

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Taka teaches first memory and second memory are installed in the camera body since , at columns 3 and 4, Figs. 1 and 2 , Taka teaches the internal circuits inside the camera including the first memory and second memory and buttons mount on camera body used for operating the first memory and second memory .

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tojo et al in view of Pfeiler et al (4,709,385) .

1. Regarding claims 50 -55, Tojo discloses a recording/reproducing apparatus (Fig. 1) reproducing the images signal . The apparatus comprises:

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a first storing means (7) installed inside the camera body for storing a plurality of images column 2, lines 61-65);

a second memory (20) installed inside the camera body for storing a plurality of images;

a reproducing means having electrical connections to the first storing memory and second memory for reproducing the image signals from the first memory and the image signal from the second memory ; and

a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 18, lines 17-26, column 7, lines 14-20).

Tojo fails to teaches the use of a buffer memory for storing the image from the first memory or second memory Pfeiler teaches a camera having a memory receiving the images from one of two memories (8,9) (Fig. 1, image memory 12) via electrical connections . Therefore, it would have been obvious to one of ordinary skill in the art to modify Tojo by using a memory as taught by Pfeiler for storing the image signals from the first memory or second memory in order to easily control the timing of the image signal to be output to another device.

6. Claims 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taka (5,162,833) al in view of Pfeiler et al (4,709,385) .

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Regarding claims 50-55, Taka discloses a camera having a recording/reproducing apparatus (Fig. 1) for recording and reproducing the image signal. The apparatus comprises:

- a first storing means (10) for storing a plurality of images (column 3, lines 53-65)column 2, lines 61-65);

- a second memory (12) for storing a plurality of images;

- a reproducing means (14,16) having electrical connections to the first memory and the image signal from the second memory for reproducing the image information from the first memory and the second memory

- a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 8, lines 38-42, column 12, lines 55-60).

Taka fails to teaches the use a memory for receiving the images from the first memory or second memory.

Pfeiler discloses an apparatus for reproducing the image having a memory (12) for receiving the image signal to be reproduced on a display from one of two other memories via electrical connections (8 and 9).

It would have been obvious to one of ordinary skill in the art to modify Taka with Pfeiler by using a memory as taught by Pfeiler for receiving the image from the first or second memory in order to easily control the timing of the image to be reproduced on a display.

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7. Claim 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taka (5,162,833) al in view of Sasaki et al (5,034,804).

Taka fails to teaches that the first memory is detachable memory . However, it is noted that using a detachable memory for storing the images is well known in the art as taught by Sasaki . Therefore, it would have been obvious to one of ordinary skill in the art to modify Taka with Sasaki by using a detachable memory as an alternative the first memory of Taka in order to easily replace the first memory.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered and the examiner response to applicant argument has been addressed below.

Applicant argues that "The Tojo patent does not show or suggest a device where the first and second memories are installed inside the camera body."

In response, it is noted that Tojo teaches that the first memory and second memory are installed in a camera body since the recorder 2 can be attached to the image pick up apparatus to form a camera apparatus having a body and the first memory and second memory are installed inside the camera body. (Figs. 1, 2, column 9, line 21 to column 10, line 20).

Applicant argues that " the Tojo patent does not show or suggest a device where the first and second memories are mounted inside the camera body and there **is no facility for displaying the information stored in memory 7**. To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, the



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Tojo patent does not anticipated claim 47. Claims 48 and 49 are dependent on claim 47 and thus include every limitation of claim 47. Therefore, the Tojo patent does not anticipate claims 48 and 49."

In response, it is noted that Tojo at column 3, lines 10-25, column 7, lines 16-24 teaches that the image signal from the first memory and second memory are selectively transmitted to monitor 10 ( viewfinder mount on the camera body ) for reproducing and displaying the images.

Applicant argues that " **the Taka patent does not show or suggest a device where the first and second memories are mounted inside the camera body.** To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, the Taka patent does not anticipated claim 47. Claims 48 and 49 are dependent on claim 47 and thus include every limitation of claim 47. Therefore, the Taka patent does not anticipate claims 48 and 49."

In response, the examiner disagrees . It is noted that a Figs. 1 and 2 in Taka reference illustrate the circuits inside the camera . The circuits include a first memory and a second memory (recall memory and special memory) (column 4-4). Fig. 2 Taka further teaches the operative buttons mounted on the camera body to control the first memory and second memory .It is clear that the first memory and second memory are inside the body of the camera .

Applicant further agues that "Claim 43 is dependent upon claim 42 and thus includes every limitation of claim 42. As noted above, with regard to claim 42, the **Taka**

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**patent is indefinite as to the position of the special memory**, and thus does not show or suggest a device where the first and second memories are installed inside the camera body. The Sasaki patent merely shows the use of a single memory 15.

Therefore, the Sasaki patent also does not show or suggest a device where the first and second memories are installed inside the camera body. To support a prima facie case of obviousness, the combined references must show or suggest every limitation of the claim". In response, it is noted that Taka patent teaches position of the special memory, at Fig. 1 column 3, Taka teaches the special memory is installed inside the camera and Fig. 2 Taka teaches the use of button mounted on the camera body to operate the special memory. It is clear that Taka teaches the special memory is installed inside the camera body.

Applicant argues that "the Tojo fails to teach the use of a memory for storing the image signal and the Pfeiler patent does not show the use of a memory for temporarily storing the image information, but rather memory 12 is used to store the output of differencing unit 11. Thus, the Tojo and Pfeiler patents, even when combined, do not show or suggest every limitation" of claims 50 and 54.

In response, it is noted that the combination of Tojo and Pfeiler teaches electrical connection between the first memory and second memory since Tojo teaches electrical connections between the first memory and second memory to a reproducing device. The image signal from either first or second memory is selected to the reproducing device and Pfeiler teaches electrical connections between the first memory and second memory and the image from either first memory or second

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memory is provided to a memory for processing and the image from the memory forwarded to a reproducing device for displaying the images. Further it is noted that the memory as taught by Pfeiler is considered as a buffer for temporary storing the images since the image from the first memory or second memory is stored in the memory and then is forwarded to a display device for displaying. Applicant further argues that “ **memory 12 is used to store the output of differencing unit 11.**”. In response, it is noted that the output of the differencing is also image information. Further it is noted that the examiner relies on Pfeiler that is being teaching the connections between the first memory and second memory and a memory to combine with Tojo reference.

Applicant argues that “The rejection states that “Taka fails to teach the use of a memory for receiving the images from the first or second memory.” (Office Action, page 5) As noted above, **the Pfeiler patent does not show the use of a memory for temporarily storing the image information, but rather memory 12 is used to store the output of differencing unit 11.** Thus, the Taka and Heiler patents, even when combined, do not show or suggest every limitation” of claims 50. and 54.

In response, it is noted that the combination of Taka and Pfeiler teaches electrical connection between the first memory and second memory and the out from the first or second memory is forwarded to the a temporary memory via electrical connections since Taka teaches electrical connections between the first memory and second memory to a reproducing device. The image signal from either first or second memory is selected to the reproducing device and Pfeiler teaches electrical

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connections between the first memory and second memory and the image from either first memory or second memory is provided to a memory for processing and the image from the memory forwarded to a reproducing device for displaying the images. Further it is noted that the memory 12 as taught by Pfeiler is considered as a buffer for temporary storing the images since the image from the first memory or second memory is stored in the memory and then is forwarded to a display device for displaying. Applicant further argues that “ **memory 12 is used to store the output of differencing unit 11.**”. In response, it is noted that the output of the differencing unit is also image information. Further it is noted that the examiner relies on Pfeiler that is being teaching the connections between the first memory and second memory and a temporary storing memory to combine with Tojo reference.

9. The article "Brochure describing Digital Still Camera System, produced by Toshiba Corp." in IDS filed 4/23/2001 has not been considered by Examiner since it lacks the date data

10. Request for Approval of Proposed Drawing Changes was filed on January 24, 2001 has been received and approved by the Examiner.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER customer service whose telephone number is (703) 306-0377.

H.N  
April 6, 2003

  
HUY NGUYEN  
PRIMARY EXAMINER